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Legal Staff

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATIONS

In Re the Application of:

McMAUGHLIN et al.

Int'l. Serial No.: PCT/US97/08842

Int'l. Filing Date: 05 June 1997

Priority Date: 14 March 1997

For: "COPY PROTECTABLE OPTICAL
MEDIA DEVICE AND
METHODOLOGY THEREFOR"

Atty. File No.: 3699-2-PUS

Box PCT
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

The above-referenced PCT application was filed in the U.S. Receiving Office indicating that each of the six (6) inventors was also an applicant for purposes of the United States. Each inventor's nationality and country of residence was indicated. The corporate applicant was designated as applicant for all countries except the United States. The maximum designation fee was paid and the United States was the designated search authority.

Unfortunately, the United States designation was not checked in Box No. V of the Request form.

On July 18, 1997, an invitation to correct defects was received and the discrepancy between the information provided in Boxes III and V was noted. Attention was also drawn to the need to submit powers of attorney from each inventor/applicant. Applicant responded to all of the items noted in this invitation to correct defects, but not to the noted discrepancy. At the same time, Applicant received a "corrected" Page 1 of the Request in which the U.S. Receiving Office "changed" the corporate applicant from applicant for "all designated states except the U.S.A." to applicant for "all designated states". This "correction" was made in reverse as page 1 was correct

as submitted. The omission was the X on page 4. The status of the six inventors remained unchanged: applicant/ inventors for the United States of America only.

On October 3, 1997, PCT form RO/132 was received which indicated that powers of attorney were still required from two of the inventor/applicants. This requirement was met and the application proceeded as if the assignee company were an applicant for all states but the United States, and the inventors were applicants for purposes of the United States. Subsequently, a Chapter II Election was made in which the corporate applicant and the inventor/applicants were all listed. There was no request to correct the Demand. It appears that the USRO acted as if the inventors were applicants for purposes of the United States but that this information was not conveyed to the International Bureau.

Applicant asserts that the failure to put an “[X]” in Box V of the Request form is an obvious error correctable under PCT Rule 91.1(a). The fact that an “[X]” did not appear next to the U.S. designation should not be construed as a fatal error, as clearly the information submitted for the six inventors/applicants was an indication that there was a clear intention to designate the United States. There would be no need to say that the inventors were applicants if the United States were not designated. In reality, this application proceeded as if the inventors were applicants.

Applicant relies on the holding in Helfgott & Karas P.C. v. Dickerson, 54 USPQ 2ND 1425 (Fed. Cir. 2000), in which the Commissioner’s refusal to grant relief under 37 C.F.R. § 1.183 an abuse of discretion. The Court held that “where the applicant points out an ‘obvious’ error upon which there is no disagreement, and an ‘obvious’ fix for that error, Rule 91.1 authorizes the entry of such corrections.” Enclosed herewith please find a corrected Page 4, of the Request which comprises Box V and which includes an “[X]” next to the United States of America designation.

Further, the application, designating the United States, became unintentionally abandoned after September 14, 1999, for failure to enter the U.S. national phase in a timely manner. The entire delay in entering the U.S. national phase was unintentional. Applicant hereby respectfully requests that the U.S. Patent and Trademark Office (DO/EO/US) now revive the above-identified application to permit national stage prosecution in the U.S.

Enclosed please find the following:

- 1) A check in the amount of \$1,210.00 pursuant to 37 C.F.R. §1.17(m) in payment of the fee for revival of an unintentionally abandoned application;
- 2) Transmittal letter to the U.S. Designated/Elected Office for a national stage filing under 35 U.S.C. §371;
- 3) A check in the amount of \$1,896.00 in payment of filing fees;
- 4) A check in the amount of \$40.00 for recording the assignments;
- 5) Executed Combined Declarations/Powers of Attorney from the six inventors;
- 6) Assignments under separate cover sheet; and
- 7) A corrected page 4 of the Request.

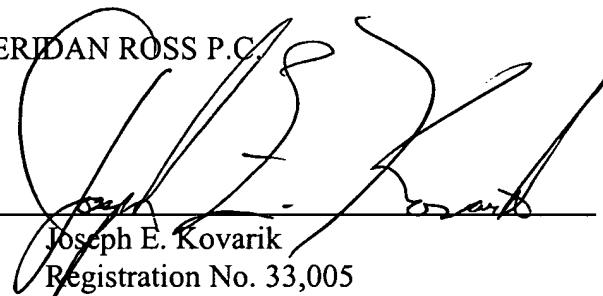
We believe that no additional fees are due with this communication. If any additional fees are due, however, please debit such fees to Deposit Account No. 19-1970.

Applicant notes that it is within the discretion of the Commissioner to grant this request for correction and respectfully requests that this request be granted. We very much appreciate your consideration of this Petition. If further information is required in order to restore the application to pending status, please contact the undersigned attorney at (303) 863-2977. Thank you.

Respectfully submitted,

SHERIDAN ROSS P.C.

By:


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1560 Broadway, Suite 1200
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(303) 863-9700

Date: 9/13/00

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23-7-1020

One Thousand Two Hundred Ten Dollars and no/cents *****

DATE

9/13/2000

AMOUNT

\$1,210.00

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Commissioner of Patents and Trademarks

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105545

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Forty Dollars and no/cents *****

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\$40.00

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23-7-1020

One Thousand Eight Hundred Ninety-six Dollars and no/cents *****

DATE

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\$1,896.00

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► DESIGNATION OF STATE

The following designations are hereby made under Rule 4.9(a) (mark the applicable check-boxes; at least one must be marked):

Regional Patent

AP ARIPO Patent: KE Kenya, LS Lesotho, MW Malawi, SD Sudan, SZ Swaziland, UG Uganda, and any other State which is a Contracting State of the Harare Protocol and of the PCT

EA Eurasian Patent: AZ Azerbaijan, BY Belarus, KZ Kazakstan, RU Russian Federation, TJ Tajikistan, TM Turkmenistan, and any other State which is a contracting State of the Eurasian Patent Convention and of the PCT

EP European Patent: AT Austria, BE Belgium, CH and LI Switzerland and Liechtenstein, DE Germany, DK Denmark, ES Spain, FR France, GB United Kingdom, GR Greece, IE Ireland, IT Italy, LU Luxembourg, MC Monaco, NL Netherlands, PT Portugal, SE Sweden, and any other State which is a Contracting State of the European Patent Convention and of the PCT

OA OAPI Patent: BF Burkina Faso, BJ Benin, CF Central African Republic, CG Congo, CI Côte d'Ivoire, CM Cameroon, GA Gabon, GN Guinea, ML Mali, MR Mauritania, NE Niger, SN Senegal, TD Chad, TG Togo, and any other State which is a member of State of OAPI and a Contracting State of the PCT (*if other kind of protection or treatment desired, specify on dotted line*).....

National Patent (if other kind of protection or treatment desired, specify on dotted line):

<input checked="" type="checkbox"/> AL Albania	<input checked="" type="checkbox"/> LU Luxembourg
<input checked="" type="checkbox"/> AM Armenia	<input checked="" type="checkbox"/> LV Latvia
<input checked="" type="checkbox"/> AT Austria	<input checked="" type="checkbox"/> MD Republic of Moldova
<input checked="" type="checkbox"/> AU Australia	<input checked="" type="checkbox"/> MG Madagascar
<input checked="" type="checkbox"/> AZ Azerbaijan	<input checked="" type="checkbox"/> MK The former Yugoslav Republic of Macedonia
<input checked="" type="checkbox"/> BA Bosnia and Herzegovina	<input checked="" type="checkbox"/> MN Mongolia
<input checked="" type="checkbox"/> BB Barbados	<input checked="" type="checkbox"/> MW Malawi
<input checked="" type="checkbox"/> BG Bulgaria	<input checked="" type="checkbox"/> MX Mexico
<input checked="" type="checkbox"/> BR Brazil	<input checked="" type="checkbox"/> NO Norway
<input checked="" type="checkbox"/> BY Belarus	<input checked="" type="checkbox"/> NZ New Zealand
<input checked="" type="checkbox"/> CA Canada	<input checked="" type="checkbox"/> PL Poland
<input checked="" type="checkbox"/> CH and LI Switzerland and Liechtenstein	<input checked="" type="checkbox"/> PT Portugal
<input checked="" type="checkbox"/> CN China	<input checked="" type="checkbox"/> RO Romania
<input checked="" type="checkbox"/> CU Cuba	<input checked="" type="checkbox"/> RU Russian Federation
<input checked="" type="checkbox"/> CZ Czech Republic	<input checked="" type="checkbox"/> SD Sudan
<input checked="" type="checkbox"/> DE Germany	<input checked="" type="checkbox"/> SE Sweden
<input checked="" type="checkbox"/> DK Denmark	<input checked="" type="checkbox"/> SG Singapore
<input checked="" type="checkbox"/> EE Estonia	<input checked="" type="checkbox"/> SI Slovenia
<input checked="" type="checkbox"/> ES Spain	<input checked="" type="checkbox"/> SK Slovakia
<input checked="" type="checkbox"/> FI Finland	<input checked="" type="checkbox"/> TJ Tajikistan
<input checked="" type="checkbox"/> GB United Kingdom	<input checked="" type="checkbox"/> TM Turkmenistan
<input checked="" type="checkbox"/> GE Georgia	<input checked="" type="checkbox"/> TR Turkey
<input checked="" type="checkbox"/> HU Hungary	<input checked="" type="checkbox"/> TT Trinidad and Tobago
<input checked="" type="checkbox"/> IL Israel	<input checked="" type="checkbox"/> UA Ukraine
<input checked="" type="checkbox"/> IS Iceland	<input checked="" type="checkbox"/> UG Uganda
<input checked="" type="checkbox"/> JP Japan	<input checked="" type="checkbox"/> US United States of America
<input checked="" type="checkbox"/> KE Kenya	<input checked="" type="checkbox"/> UZ Uzbekistan
<input checked="" type="checkbox"/> KG Kyrgyzstan	<input checked="" type="checkbox"/> VN Viet Nam
<input checked="" type="checkbox"/> KP Democratic People's Republic of Korea	Check-boxes reserved for designating States (for the purposes of a national patent) which have become party to the PCT after issuance of this sheet:
<input checked="" type="checkbox"/> KR Republic of Korea	<input checked="" type="checkbox"/> YU Yugoslavia
<input checked="" type="checkbox"/> KZ Kazakhstan	<input type="checkbox"/> []
<input checked="" type="checkbox"/> LC Saint Lucia	<input type="checkbox"/> []
<input checked="" type="checkbox"/> LK Sri Lanka	<input type="checkbox"/> []
<input checked="" type="checkbox"/> LR Liberia	
<input checked="" type="checkbox"/> LS Lesotho	
<input checked="" type="checkbox"/> LT Lithuania	

Check-boxes reserved for designating States (for the purposes of a national patent) which have become party to the PCT after issuance of this sheet:

YU Yugoslavia
[]
[]
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In addition to the designations made above, the applicant also makes under rule 4.9(b) all designations which would be permitted under the PCT except the designation(s) of _____ . The applicant declares that those additional designations are subject to confirmation and that any designation which is not confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit. (Confirmation of a designation consists of the filing of a notice specifying that designation and the payment of the designation and confirmation fees. Confirmation must reach the receiving Office within the 15-month time limit.)